

REMARKS

Review and reconsideration of the final Office Action mailed April 15, 2009 (hereinafter "Office Action"), is respectfully requested in view of the above amendments and the following remarks. No fees are believed due; however, the Commissioner is hereby authorized to charge any deficiencies or credit any surpluses to Deposit Account No. 14-1437.

In the Office Action, claims 10 and 13-20 were pending, with all claims being rejected as being obvious. By this Amendment, claims 10 and 17 have been amended, claims 13, 14, and 19 have been canceled, and no claims have been added. No new matter has been added.

The amendments presented herein have been made solely to expedite prosecution of the instant application to allowance and should not be construed as an indication of Applicant's agreement with or acquiescence to the Examiner's position. Accordingly, Applicants expressly maintain the right to pursue broader subject matter through subsequent amendments, continuation or divisional applications, reexamination or reissue proceedings, and all other available means. The rejections and responses thereto are set forth fully below.

Claims Rejections – 35 U.S.C. § 103

In the Office Action, claims 10, 13, 14, 16 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication WO 86/05389 to Mackles (hereinafter "Mackles WO") in view of U.S. Patent Application Publication No. 2003/0049212 issued to Robinson *et al.* (hereinafter "Robinson"), U.S. Patent Patent No. 4,187,287 issued to Schreiber *et al.* (hereinafter "Schreiber"), U.S. Patent Application Publication No. 2001/0003565 issued to Mcosker *et al.* (hereinafter "Mcosker"), and U.S. Patent No. 5,340,390 issued to Magauran *et al.* (hereinafter "Magauran"). The Examiner asserts that Example 1 of Mackles WO discloses a composition containing:

- (i) 35% Valfor 950,
- (ii) 0.5% Cabosil M-5 as a thickener,

- (iii) 6% decaglycerol tetraoleate as an emollient,
- (iv) 2% polyethylene glycol 400 dioleate as a nonionic surfactant, and
- (v) 51.20 % partially hydrogenated soybean oil as a triglyceride.

The Examiner asserts that the differences between Example 1 of Mackles WO and the claims are that: (i) Mackles WO does not disclose a zeolite with an Si:Al ratio in the range of 2-5:1, and (ii) that Mackles WO does not disclose the claimed thickeners. The Examiner asserts that the remaining references correct these deficiencies. For example, the Examiner asserts it would be obvious to substitute Cabosil M-5 with a castor oil derivative and that it would be obvious to substitute Valfor 950 with MOLSIV adsorbent 3A.

Claims 13 and 14 have been canceled. Prior to addressing the cited references, Applicants wish to review the claimed cosmetic self-warming product as set forth in amended claim 10 (from which claims 16 and 20 depend), which recites:

10 (currently amended): A cosmetic self-warming product for skin cleansing, comprising a composition which is substantially water-free and contains:

15 to 25 % ~~0.1 to 40 %~~ by weight of a hydrophilic aluminum-rich zeolite with a pore size in the range of 0.3 to 0.5 nm,

20 to 70% ~~[[1 to 99 %]]~~by weight of a disperse oil phase, selected from the group consisting of triglycerides, silicone oils and mixtures thereof,

0.1 to 50 % by weight of a non-ionic surface-active agent,

10 to 25 % by weight of an emollient,

0.1 to 20 % by weight of a thickener, selected from the group consisting of polyethylene, 12-hydroxy stearic acid, waxes, and mixtures thereof, and

ad 100 % by weight cosmetic carrier substances, auxiliary substances, active substances and mixtures thereof,

with the proviso that no polyvalent alcohols and polar solvents are contained in the product, wherein the product contains a zeolite with a Si/Al ratio in the range of 2-5:1, wherein said composition is in the form of a hand cream, face mask, foot scrub or lotion.

The claimed cosmetic self-warming product includes 0.1 to 20 wt-% of a thickener selected from the group consisting of polyethylene, 12-hydroxy stearic acid, waxes and

mixtures thereof; 10 to 25 wt-% emollient; and 15 to 25 % by weight of a hydrophilic aluminum-rich zeolite with a pore size in the range of 0.3 to 0.5 nm. The hydrophilic aluminum-rich zeolite has an Si/Al ratio in the range of 2:1 to 5:1. The combination of these higher concentrations of emollients and the specified amounts of hydrophilic aluminum-rich zeolites, in combination with the other claimed ingredients, produces the unexpectedly large temperature rise while simultaneously providing a soothing skin feel. Unexpectedly, the silky smooth feeling is achieved with a composition in the form of a hand cream, face mask, foot scrub or lotion.

Applicants respectfully submit that the cited references do not disclose or suggest at least the claimed features of (i) the claimed amount of emollient, (ii) the claimed amount of hydrophilic aluminum-rich zeolite, (iii) the claimed amount of disperse oil phase, (iv) a zeolite containing composition capable of producing the claimed skin temperature increase of 4 to 8K, *i.e.*, with a Si to Al ratio ranging from 2-5:1, (v) the claimed amount of thickener, *i.e.*, 0.1 to 20% by weight, (vi) the claimed product in the form of a hand cream, face mask, foot scrub or lotion, or (vii) a combination thereof. These features are necessary to achieve the unexpected silky smooth feel described in the specification and the claimed skin-warming properties expressly claimed in claims 17 and 20, and present in the claimed self-warming product of claim 10.

Although the Office Action asserts that Example 1 of Mackles WO includes 6% decaglycerol tetraoleate *as an emollient*, Applicants note that Mackles WO teaches that decaglycerol tetraoleate *is a foaming agent*. *See* Mackles WO, page 4, ln. 15-19; page 5, ln. 8-12; and page 6, ln. 6-15. The Mackles WO reference is drawn to a stable, anhydrous aerosol foam that may contain a particulate solid capable of absorbing water exothermically. The anhydrous aerosol foam is prepared by combining particulate solids, *e.g.*, zeolites, with a foamable liquid oil, a foaming agent and a propellant. *See* Mackles WO, Abstract. On page 7 of the Office Action, the Examiner states “the delivery system of Mackles which includes the claimed emollient provides a soft, silky, and cosmetically elegant feel to the skin (p.3

lines 5-9).” Applicants submit that the “soft, silky, and cosmetically elegant feel” that is allegedly provided by the compositions of Mackles WO is achieved by the form of the composition, *i.e.*, a foam produced by a propellant, not by the ingredients of the composition, but. See page 3, lines 2-7 and lines 9-17 of Mackles WO. This is expressly taught by Mackles WO:

[I]t is presently believed that the expansion of the formulations caused by the present of the propellant causes the product to spread in the form of a thin film on the skin, thereby giving a soft, silky and cosmetically elegant feel. The observed effect is analogous to a comparison between whipped cream and butter. While both of these products are produced from cream, butter is a dense, greasy water in oil emulsion, whereas whipped cream is a light air in oil emulsion in which the oil is extended over a much greater volume, thereby masking its greasy properties to a substantial extent. In the present invention, by foaming the oils with a propellant to produce a low density aerated whip or mousse, the greasy property of the oil in the formulation is eliminated.

Mackles WO, Page 3, ln. 3-17.

Thus, based on the express teaching of Mackles WO, one of ordinary skill in the art would understand that the “soft, silky, and cosmetically elegant feel” described in Mackles WO would only be present in foam compositions, not the creams, masks and lotions of the claimed cosmetic self-warming products. In stark contrast, the silk-like feel of the presently claimed cosmetic product is unexpectedly achieved with a non-foam cream or lotion including different ingredients than those disclosed in Mackles WO.

This unexpected result occurs because of the interactions of each of the claimed ingredients with each other and cannot be understood by analyzing any single ingredient individually. Applicants respectfully note that proper consideration of the claims requires consideration of the invention *as a whole*, not separate, piecemeal consideration of each claim element. MPEP 2141.02. . In section 2141.02, the MPEP instructs:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

MPEP 2141.02.

In view of this requirement, Applicants respectfully submit that the substantial, unmotivated substitutions to the primary reference, Mackles WO, would not be made when the differences between Mackles and the claims are considered as a whole rather than discrete, unrelated substitutions as has been done in the Office Action. Applicants respectfully submit that the rejection is supported by nothing more than improper hindsight analysis.

The presently claimed cosmetic product includes 15-25% by weight of a hydrophilic aluminum-rich zeolite, different thickeners than those disclosed in Mackles WO, and 10-25% by weight of an emollient. None of these features are disclosed or suggested by Mackles WO. Furthermore, the claims are drawn to a completely different form than that required by Mackles WO. Unexpectedly, the claimed cosmetic products produce a silky, smooth feel even though that proceed contrary to the teaching of Mackles WO, which indicates cosmetic products having high levels (20-70%) of an oil phase would have an oily, greasy feel, like butter. Mackles WO, Page 3, ln. 3-17.

In contrast to Mackles WO, the claimed cosmetic self-warming product includes 10 to 25 wt-% emollient. Even if the 6% decaglycerol tetraoleate disclosed in Mackles WO is an emollient, the present claims are directed to a cosmetic product including **10-25%** by weight of an emollient. On page 7, lines 16-18, Mackles WO discloses that the preferred amount of emollient is 4 to 6 % by weight. This amount of emollient, in combination with the other claimed ingredients in the claimed amounts, is necessary to produce particularly intense warming effect and leave a special, silk-like feeling on the skin.

As stated by the Office Action, Mackles WO does not teach the specific zeolite with a Si/Al ratio in the range of 2-5:1. Robinson is relied upon to disclose MOLSIV adsorbent 3A compounds which allegedly meet the limitation for a zeolite with a Si/Al ratio in the range of 2-5:1. Applicants submit that the claims as amended herein are patentable over the combination of Mackles WO and Robinson for several reasons. First, in Examples 16-18, Robinson teaches anhydrous skin creams with MOLSIV 3A with **25-35 wt-% polyvalent alcohols** such as butylene glycol, polyethylene glycol and glycerin. Such polyvalent alcohols are expressly excluded from the claimed cosmetic products.

In addition, Robinson discloses an oil content of 15% cyclomethicone. The oil content of Robinson cannot be a basis for the desired water-repellent effect according to page 3, paragraph [00011] of the present application. Furthermore, one cannot consider the effect of the zeolite on its own, but must consider the effect of the zeolite along with the other ingredients of a cosmetic product as well as the *form* of the finished product. The compositions disclosed in Mackles WO and Robinson are not only very different from the presently claimed cosmetic product, but they are very different from each other. Because of this, no person of ordinary skill in the art would rely on combinations of these two completely different compositions. This is particularly true, because Mackles WO teaches that foams are very different from other forms of cosmetic products.

Even if one were to modify Mackles WO using Robinson, one of skill in the art would not replace only one component of a formula disclosed in Mackles WO with ingredients from a completely different skin care composition. Such as substitution includes the polyhydric alcohols disclosed in paragraph [0072] of Robinson, with a tacky solvent, a silicone elastomer and thickeners such as carboxy acid polymers (paragraph [0120] of Robinson), polyacrylamide polymers (paragraph [0125] of Robinson), polysaccharides (paragraph [0128] of Robinson) and gums (paragraph [0131] of Robinson).

Still further, Mackles WO provides a strong teaching away from using zeolites with the claimed Si to Al ratio as explained in the response and the Hwang Declaration filed March 12,

2009. The Hwang Declaration also established that, even using pure zeolite according to Mackles WO, it is simply not possible to produce the skin warming effect of the claimed cosmetic self-warming composition. Thus, even *if* Robinson discloses the existence of zeolites having a Si to Al ratio of 2-5:1, (i) there would be no motivation to combine the references in such a way to produce the claimed cosmetic self-warming product, and (ii) the claimed skin warming effect cannot be achieved using the preferred zeolites of Mackles WO.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. Applicants also direct the Examiner to *In re Fritch* (23 USPQ 2d 1780 (1783, 1784)):

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so...

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction or manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

The prior art should suggest the desirability of such a combination, see also *Berghauser v. Dann*, *Comr. Pats.* (DCDC 1979) 204 USPQ 393; *ACS Hospital Systems, Inc. v. Montefiore Hospital* (CAFC 1984) 732 F2d 1572, 221 USPQ 929; *In re Regel et al.* (CCPA 1975) 526 F2d 1399, 188 USPQ 136. The same applies with respect to the motivation to combine prior art teachings. *Markovitz v. Camiros Ltd.* (DC N III 2003) 2003 WL 21517364 (N.D. III). The CAFC has identified three possible sources of a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art

(but not the high level of skill alone of those persons). *In re Rouffet*, (CAFC 1998) 149 F3d 1350, 47 PQ2d 1353.

To properly combine two references to reach a conclusion of obviousness, there must be some teaching, suggestion or inference in either or both of the references, or knowledge generally available to one of ordinary skill in the art, which would have led one to combine the relevant teachings of the two references. *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc. et al* (CAFC 1985) 776 F2d 281, 227 USPQ 657. Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art, not in applicant's disclosure.

Based on the foregoing, the cited references do not render the present invention obvious within the meaning of 35 U.S.C. 103. Applicants submit that the combination of references fails to teach or suggest all the claim limitations of the present claims, that the cited references do not disclose or suggest the unexpectedly superior properties of the claimed cosmetic self-warming product, which produces a particularly intense warming effect and leaves a special, silk-like feeling on the skin, and that there is no suggestion in the references or the combination thereof to combine or modify the teachings of the prior art to produce the claimed invention.

Applicants respectfully submit that the claims as amended herein are patentable over the combination of Mackles WO and Robinson for at least the reasons cited above. The claims as amended herein are also patentable over the combination of Mackles WO, Robinson, Schreiber, Mcosker, and Magauran because (1) Schreiber, Mcosker and Magauran fail to overcome the deficiencies identified above, (2) the combination of references fails to teach all the claim limitations present in the pending claims, and (3) none of these references provide motivation for combining Mackels WO with any one or more of Robinson, Schreiber, Mcosker and Magauran. Accordingly, Applicants respectfully request that the rejection based on the combination of Mackles WO, Robinson, Schreiber, Mcosker, and Magauran be withdrawn.

In the Office Action, claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles WO in view of Robinson, Schreiber, Mcosker, Magauran, and further in view of U.S. Patent No. 6,274,128 issued to Bergmann *et al.* (hereinafter "Bergmann"). The claims as amended herein are patentable over the combination of Mackles WO, Robinson, Schreiber, Mcosker, and Magauran for the reasons cited above. Regarding Bergmann, this reference actually teaches away from the claimed invention. In Examples 1-4, Bergmann teaches glycerine in the conditioners, which is a polyvalent alcohol. According to the teachings of the present application, use of polyvalent alcohol is to be avoided. See the pending claims which recite "with the proviso that no polyvalent alcohols and polar solvents are contained in the product..."). Thus, one of skill in the art would not be motivated to combine Bergmann with Mackles WO, Robinson, Schreiber, Mcosker, or Magauran to produce the claimed invention. As no combination of Schreiber, Mcosker, Magauran and Bergmann overcomes the deficiencies identified above, Applicants respectfully request that the rejection based on the combination of Mackles WO, Robinson, Schreiber, Mcosker, Magauran and Bergmann be withdrawn.

Claims 17-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mackles WO in view of Robinson, Schreiber, Mcosker, Magauran, and further in view of U.S. Patent No. 5,322,683 issued to Mackles *et al.* (hereinafter "Mackles '683"). As the additional Mackles '683 reference fails to overcome the deficiencies identified above, Applicants respectfully request that the rejection based on the combination of Mackles WO, Robinson, Schreiber, Mcosker, Magauran and Mackles '683 be withdrawn.

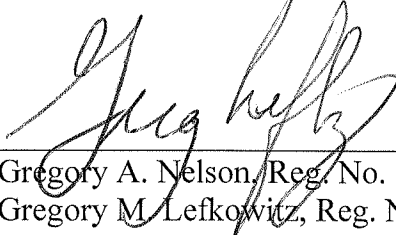
Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The

application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

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